

SOLICITORTO: **Mail Stop 8****Director of the U.S. Patent & Trademark Office****P.O. Box 1450****Alexandria, VA 22313-1450****AUG 14 2008****U.S. PATENT & TRADEMARK OFFICE****REPORT ON THE
FILING OR DETERMINATION OF AN
ACTION REGARDING A PATENT OR
TRADEMARK**

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. CV 08-03827 JCS	DATE FILED 08/11/08	U.S. DISTRICT COURT 450 Golden Gate Ave., San Francisco, CA 94121
PLAINTIFF CHIPMOS TECHNOLOGIES INC		DEFENDANT TESSERA INC
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 5,663,106		See attached document
2		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
2			
3			
4			
5			

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wicking	(BY) DEPUTY CLERK Susan Imbriani	DATE August 12, 2008
------------------------------------	--------------------------------------------	--------------------------------

Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

SEYFARTH SHAW LLP
Lawrence E. Butler (SBN 111043)
Email: lbutler@seyfarth.com
560 Mission Street, Suite 3100
San Francisco, California 94105
Telephone: (415) 397-2823
Facsimile: (415) 397-8549

ORIGINAL
FILED

AUG 11 2008

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND

ADR

Attorneys for Plaintiffs
CHIPMOS TECHNOLOGIES INC., CHIPMOS TECHNOLOGIES
(BERMUDA) LTD. and CHIPMOS U.S.A., INC.

FILED

UNITED STATES DISTRICT COURT

IN AND FOR THE NORTHERN DISTRICT OF CALIFORNIA

C08-03827 JCS

CHIPMOS TECHNOLOGIES, INC.,
CHIPMOS TECHNOLOGIES (BERMUDA)
LTD. AND CHIPMOS U.S.A., INC.,

Case No.

Plaintiffs,

**COMPLAINT FOR DECLARATORY
JUDGMENT OF NON
INFRINGEMENT AND INVALIDITY
OF U.S. PATENT NO. 5,663,106**

v.

DEMAND FOR JURY TRIAL

TESSERA, INC.

Defendant.

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiffs, ChipMOS TECHNOLOGIES Inc., ChipMOS TECHNOLOGIES (Bermuda)
Ltd. and ChipMOS U.S.A., Inc. (collectively "ChipMOS"), for their Complaint against Tessera
Inc. ("Tessera"), herein allege as follows:

NATURE OF CLAIM

1. This action seeks a declaratory judgment from this Court, pursuant to the
Declaratory Judgment Act, 28 U.S.C. § 220, that under the Patent Act of the United States, 35
U.S.C. §101 *et seq.*, ChipMOS has not and does not infringe, either directly, contributorily or by
inducement, U.S. patent no. 5,663,106 ("106 patent"), and that the claims of the '106 patent are
invalid under the Patent Act of the United States, 35 U.S.C. §101 *et seq.* A copy of the '106
patent is attached hereto as Exhibit A.

1 **PARTIES**

2 2. ChipMOS TECHNOLOGIES Inc. is a corporation organized and existing under
3 the laws of the Republic of China, having its principal place of business at No. 1 R&D Road 1,
4 Science Based Industrial Park, Hsinchu, Taiwan, Republic of China.

5 3. ChipMOS TECHNOLOGIES (Bermuda) Ltd. is a corporation organized and
6 existing under the laws of Bermuda, having its place of business at 11 F, No. 3, Lane 91,
7 Dongmei Road, Hsinchu, Taiwan, Republic of China.

8 4. ChipMOS U.S.A., Inc. is a corporation organized and existing under the laws
9 California, having its principal place of business at 2890 N 1st Street, San Jose, California
10 95134.

11 5. On information and belief, Tessera Inc. is a Delaware corporation having its
12 principal place of business in San Jose, California.

13 **JURISDICTION**

14 6. This Court has jurisdiction over this matter pursuant to (1) 28 U.S.C. § 2201 and
15 2202, in that it is an action seeking a declaratory judgment with respect to allegations of patent
16 infringement, that have been asserted by Tessera, and patent validity, under the United States
17 Patent Act, 35 U.S.C. § 101 *et. seq.*, and is based upon an actual controversy between ChipMOS
18 and Tessera regarding the non infringement and invalidity the '106 patent, and (2) 28 U.S.C. §§
19 1331 and 1338(a) in that this matter arises under an Act of Congress relating to patents.

20 7. This Court has personal jurisdiction over Tessera in that Tessera: (a) has a
21 principal place of business located within this district; (b) has committed the acts complained of
22 herein in this district; (c) transacts business within this district; and/or (d) has conceded
23 jurisdiction in concurrent litigation pending before Judge Wilken.

24 **VENUE**

25 8. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and (c) in that a
26 substantial part of the facts giving rise to the claims asserted herein occurred in this district and
27 this district is also the principal place of business for ChipMOS U.S.A. Inc. Moreover, venue is
28 proper in this Court in that Tessera has conceded proper venue in concurrent litigation pending

1 before Judge Wilken.

2 **FACTUAL BACKGROUND**

3 9. On September 2, 1997, the United States Patent Office issued the '106 patent,
4 entitled "Method of Encapsulating Die and Chip Carrier." (See Exhibit A, page 1)

5 10. Upon information and belief, Tessera is the owner, by assignment, of all rights,
6 title and interest in and to the '106 patent.

7 11. Tessera has threatened ChipMOS with legal proceedings for patent infringement
8 by alleging that semiconductor packages assembled by ChipMOS and used, sold, offered for sale
9 or imported into the United States, infringe one or more claims of the '106 patent. Particularly,
10 on or about July 30, 2008, Tessera informed ChipMOS that Tessera intends to move to add the
11 '106 patent to the pending International Trade Commission (ITC) Investigation entitled *In the*
12 *Matter of Certain Semiconductor Chips with Minimized Chip Package Size and Products*
13 *Containing Same (IV)*, ITC Inv. No. 337-TA-64 (the "649 Investigation"), alleging that some of
14 ChipMOS's packaging services and packages assembled by ChipMOS infringe the '106 patent.

15 12. At present, the parties are involved in two separate patent cases: (1) the 649
16 Investigation pending before the International Trade Commission; and (2) a pending patent
17 infringement case in United States District Court in the Northern District of California, Case No.
18 05-4063 CW, before the Honorable Claudia Wilken. Each case has multiple Patents in Suit and
19 concern products similar to those products which Tessera currently contends infringe the claims
20 of the '106 patent.

21 13. By reason of the foregoing, Tessera has raised a justiciable controversy and
22 ChipMOS has a reasonable apprehension that Tessera will file an action against ChipMOS for
23 infringement of the '106 patent.

24 **COUNT I**
25 **DECLARATION OF NON-INFRINGEMENT**

26 14. Plaintiff ChipMOS realleges and repeats the allegations of paragraphs 1-13 as
27 through fully set forth herein.

28 15. ChipMOS TECHNOLOGIES (Bermuda) Ltd. and ChipMOS U.S.A., Inc. do not

1 make, use, sell, offer to sell, or import any semiconductor chip assemblies or packages, or
2 assembly services relating to semiconductor packages, anywhere, including in the United States,
3 let alone any semiconductor chip assemblies, packages or assembly services that infringe any
4 claims of the '106 patent.

5 16. ChipMOS TECHNOLOGIES Inc. does not make, use, sell, offer to sell or import
6 any semiconductor chip assemblies or packages that infringe any claim of the '106 patent.

7 17. ChipMOS TECHNOLOGIES Inc. does not sell or offer to sell any semiconductor
8 chip assemblies or packages, anywhere, including in the United States, let alone any
9 semiconductor chip assemblies or packages that infringe any claim of the '106 patent.

10 18. The process used by ChipMOS TECHNOLOGIES Inc. to assemble
11 semiconductor chip assemblies or packages does infringe any claim of the '106 patent

12 19. Semiconductor chip assemblies or packages that are assembled by ChipMOS
13 TECHNOLOGIES Inc., and that are imported by anyone into the United States, do not infringe
14 any claims of the '106 patent.

15 20. ChipMOS therefore seeks a Declaratory Judgment from this Court that ChipMOS
16 TECHNOLOGIES (Bermuda) Ltd., ChipMOS U.S.A., and ChipMOS TECHNOLOGIES Inc. do
17 not directly infringe, contributorily infringe, or induce others to infringe, any claim of the '106
18 patent.

19 21. Tessera's actions have caused damages to ChipMOS, in an amount to be
20 determined at trial. Tessera's allegations of infringement of the '106 Patent to ChipMOS and/or
21 ChipMOS' customers has caused irreparable injury to ChipMOS, and, unless and until Tessera's
22 actions are enjoined by this Court, ChipMOS will continue to suffer irreparable injury because of
23 Tessera's meritless allegations. ChipMOS has no adequate remedy at law.

24 **COUNT II**
25 **DECLARATION OF INVALIDITY**

26 22. ChipMOS repeats and realleges paragraphs 1 through 21 of this Complaint as if
27 fully set forth herein.

28 23. The '106 patent, and each claim thereof, is invalid because it does not comply

with the statutory requirements of patentability enumerated in, among other things, 35 U.S.C. §§ 101, 102, 103, 112, 132, and/or 305.

24. Tessera's actions have caused damages to ChipMOS, in an amount to be determined at trial. Tessera's allegations of infringement of the '106 Patent to ChipMOS and/or ChipMOS' customers has caused irreparable injury to ChipMOS, and, unless and until Tessera's actions are enjoined by this Court, ChipMOS will continue to suffer irreparable injury because of Tessera's meritless allegations. ChipMOS has no adequate remedy at law.

PRAYER FOR RELIEF

WHEREFORE, ChipMOS TECHNOLOGIES (Bermuda) Ltd., ChipMOS U.S.A., and ChipMOS TECHNOLOGIES Inc., collectively and individually, respectfully request that the Court enter a judgment:

a. declaring that ChipMOS TECHNOLOGIES (Bermuda) Ltd., ChipMOS U.S.A., and ChipMOS TECHNOLOGIES Inc., collectively and individually, do not directly infringe, contributorily infringe or induce others to infringe any claim of the '106 patent;

b. declaring that a product that incorporates any semiconductor package or assembly that is assembled by ChipMOS TECHNOLOGIES Inc. and that is imported into the United States does not infringe any claim of the '106 patent;

c. declaring that a semiconductor packages that is assembled by ChipMOS TECHNOLOGIES Inc. and used, sold, offered for sale or imported into the United States does not infringe any claim of the '106 patent;

d. declaring that the process used by ChipMOS TECHNOLOGIES Inc. to assemble semiconductor packages or assemblies does not infringe any claim of the '106 patent;

e. declaring that the '106 patent, and each claim therein, is invalid;

f. preliminarily and permanently enjoining Tessera from threatening or otherwise representing or describing to anyone that: (a) ChipMOS' services of assembling semiconductor packages; (b) ChipMOS assembled semiconductor packages; or (c) that a product imported into the United States that includes a ChipMOS assembled semiconductor package, infringe any claim of the '106 patent;

g. ordering Tessera to pay ChipMOS the damages that it has incurred as a result of the acts complained of herein, including, but not limited to, an award to ChipMOS of their lost profits, sales and reputational harm as a result of the acts complained of herein;

h. ordering Tessera to pay ChipMOS their interest, costs and expenses of this action, and their reasonable attorneys' fees, as a result of the acts complained of herein, pursuant to 35 U.S.C. § 285; and

i. awarding ChipMOS any other relief that this Court deems just and fit.

JURY DEMAND

Pursuant to Fed. R. Civ. P. 38(b), ChipMOS TECHNOLOGIES (Bermuda) Ltd., ChipMOS U.S.A., Inc. and ChipMOS TECHNOLOGIES, Inc. demand a trial by jury of all issues triable of right by a jury.

DATED: August 11, 2008

SEYFARTH SHAW LLP

By Lawrence E. Butler
Lawrence E. Butler
Attorneys for Plaintiffs
CHIPMOS TECHNOLOGIES INC.,
CHIPMOS TECHNOLOGIES (BERMUDA)
LTD. AND CHIPMOS U.S.A., INC.